

REMARKS

The Abstract was objected to and has been amended.

Claims 14-16 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 14-16 are directed to the computer network defined in claim 13 and further define the method performed on the computer network. These claims have been amended in a non-narrowing manner to address the rejection.

Claims 1-4, 6 and 13 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner states that the claimed method fails to advance the technological arts because the steps can be performed in the mind or by use of pencil and paper. It appears that the Examiner is relying on the now defunct "mental steps" doctrine. This doctrine has been significantly curtailed, if not abolished, by the PTO. Furthermore, claims 1 and 13 now recite that the alert and report are communications generated from a legal department to a recipient and that the alert is monitored for action and the report is tracked. Such actions are not mental acts by an individual.

The Examiner also suggests that the claims lack "concreteness" because an alert or report is not generated for every litigation issue. Claims 1 and 13 cover situations where the information is analyzed and one of an alert is generated, a report is generated or no action is taken. The scenarios where an alert is generated and monitored or a report is generated and tracked clearly represent concrete events (generation of an item that is monitored or tracked).

For the above reasons, claims 1-4, 6 and 13 meet the requirements of 35 U.S.C. § 101.

Claims 1-3, 5-8, 10-15 and 17 were rejected under 35 U.S.C. § 103 as being unpatentable over Heckman in view of CPR. This rejection is respectfully traversed.

Claim 1 recites a method including "determining whether said potential litigation issues justify an alert based on a risk level of said potential litigation issues; issuing said alert as a communication from a legal department to at least one recipient if justified and monitoring an action from said alert; if said alert is not justified, determining whether said issue justifies a report based on said risk level of said potential litigation issues, said

risk level for said report being lower than said risk level for said alert; issuing said report as a communication from said legal department to at least one recipient and tracking its issuance." The method of claim 1 includes two communications, namely an alert or a report depending on the risk of the potential litigation issues.

Neither Heckman nor CPR teach or suggest a tiered litigation warning system as recited in claim 1. In Heckman, a preliminary analysis is performed (step 30) and a decision is made to proceed or not (step 31). The analysis of the case in Heckman does not involve evaluating the level of risk and issuing an alert or a report based on the level of risk. The invention of claim 1 provides multiple types of communications based on the level of risk so that recipients can be made aware of high risk litigation issues and lower risk litigation issues. Heckman fails to teach these features.

CPR was relied upon by the Examiner for teaching early dispute resolution but fails to teach the tiered litigation warning system as recited in claim 1 having alerts for higher risk litigation issues and reports for lower risk litigation issues. Thus, even if Heckman and CPR are combined as proposed by the Examiner, the invention of claim 1 does not result.

For the above reasons claim 1, is patentable over Heckman in view of CPR. Claims 2-6 depend from claim 1 and are patentable over Heckman in view of CPR for at least the reasons discussed with respect to claim 1. Claims 7-18 recite features similar to those discussed above with respect to claim 1 are patentable over Heckman in view of CPR for at least the reasons discussed with respect to claim 1.

New claim 19 recites that the "gathered data includes litigation monitoring of industry litigation, said potential litigation issues being based on said litigation monitoring of industry litigation." This allows an entity to monitor litigation filings, outcomes and trends and proactively take actions to reduce potential risk. For example, if a competitor is sued, the litigation monitoring detects this event which is considered when determining potential litigation issues. This feature is not taught or suggested by Heckman which is focused on litigation directed towards the entity implementing the strategic plan, rather than litigation against others in a common industry.

In view of the foregoing amendments and remarks, Applicant submits that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicant's attorney.

Respectfully submitted,

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